

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

OF: SCHELBERGER ET AL

SERIAL No. 09/868,515

FILED: JUNE 18, 2001

FOR: FUNGICIDAL MIXTURES BASED ON MORPHOLINE OR PIPERIDINE  
DERIVATIVES AND OXIME ETHER DERIVATIVES

Box:

CONFIRMATION No.: 1391

GROUP ART UNIT: 1617

EXAMINER:

SHAOJIA A. JIANG

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, on:

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Honorable Commissioner of

Patents and Trademarks

Washington, D.C. 20231

PETITION UNDER 37 C.F.R. §1.181

Sir:

Applicants hereby petition to the Honorable Commissioner to withdraw the Examiner's advisory action dated December 10, 2002 (Paper No. 10), and to require the Examiner to enter applicants' amendment under 37 C.F.R. §1.116 dated November 25, 2002 (date of the Certificate of Mailing, Paper No. 09) for purposes of Appeal.

On the facts which are summarized below, applicants respectfully suggest that the Examiner erred holding applicants' Claims 6 and 11, or Claim 11<sup>1)</sup>, finally withdrawn from further consideration in the

- 1) The Examiner's final action is ambiguous as to whether Claims 6 and 11 or only Claim 11 remain(s) finally withdrawn from consideration. On the one hand, form PTO-326 states in No. (4a) that Claim 6 and 11 are withdrawn from consideration. On the other hand, the Examiner states in the detailed action that "[a]pplicant's remarks (...) regarding claims 6 and 11 being drawn to a nonelected species have been considered and found persuasive as to claim 6. Therefore, claim 6 is now drawn to the elected species." (Paper No. 8, page 2, lines 5 to 7). In No. 7 of form PTO-303 accompanying the advisory action, the Examiner then indicates Claims 6 and 11 as withdrawn from consideration.

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final action dated August 27, 2002 (*Paper No. 08*). Applicants further respectfully suggest that those facts corroborate that the reasons set forth by the Examiner in the final action of August 27, 2002 (*Paper No. 08*), for holding applicants' Claims 6 and 11, or Claim 11, finally withdrawn from further consideration in the application constitute a new ground of rejection, and that applicants thus should be provided with a full and fair time period to reply, and opportunity to obviate, such new ground. In light of the advanced stage of proceedings and to avoid unnecessary delays in the prosecution of the application, applicants would consider it satisfactory if the amendment and the remarks which were submitted in their reply pursuant to Rule 116 were entered and considered by the Examiner for purposes of Appeal.

SUMMARY OF MATERIAL FACTS:

1. The application was filed in the U.S. pursuant to the provisions of Section 371 of the Patent Act on June 18, 2001. The claims submitted upon filing of the application were Claims 1 to 10.

2. The Examiner issued an election/restriction requirement on October 24, 2001 (*Paper No. 04*), requiring election of a single species and asserting lack of unity of invention under PCT Rule 13.1. Reasons why applicants' claims were considered to lack unity of invention were, however, not provided by the Examiner.

3. In their reply dated November 26, 2001 (*Monday; date of the Certificate of Mailing; Paper No. 05*), applicants elected the combination according to Example 7 comprising the compound of formula (Ia) and the compound II.79 as a representative species. In addition to a number of changes in the application, applicants entered new Claim 11 worded as follows:

*A fungicidal mixture as defined in claim 1, wherein in the compound of the formula II, R<sup>1</sup> is methylenecyclopropyl, X<sup>2</sup> is 5-F, X<sup>3</sup>, X<sup>4</sup> and X<sup>5</sup> are each H, R<sup>2</sup> is C<sub>6</sub>H<sub>5</sub>CH<sub>2</sub> and R<sup>3</sup> and R<sup>4</sup> are each H.*

4. The Examiner issued a first Office action on the merits on April 23, 2002 (*Paper No. 06*), acknowledging applicants' election of species and holding Claims 6 and 11 withdrawn from further consideration as being drawn to a non-elected species.

5. On June 26, 2002 (*date of the Certificate of Mailing; Paper No. 07*) applicants submitted their reply on the merits. Additionally, applicants revised the language of Claim 11 as follows

A fungicidal mixture as defined in claim 1, wherein in the compound of the formula II,  $R^1$  is methylenecyclopropyl,  $X^2$  is 5-F,  $X^3$  [7] and  $X^4$  [~~and~~  $X^5$ ] are each H,  $R^2$  is  $C_6H_5CH_2$  and  $R^3$  and  $R^4$  are each H.

to read on the elected species, and submitted reasons why Claim 6 as previously submitted and Claim 11 as revised were deemed by applicants to read on the elected species. Applicants also submitted in that context that restriction of the application was governed by the unity of invention criteria.

6. The Examiner issued a second Office action on the merits on October 22, 2001 (Paper No. 07), and made the Office action final. With regard to withdrawn Claims 6 and 11 the Examiner stated<sup>2)</sup>

... claim 6 is now drawn to the elected species. However, Applicant's remarks regarding claim 11 is not found persuasive since first, there are no clear definitions for  $X^1$  and  $X^5$ ; the expression "5-F" for  $X^2$  is unclear.

(emphasis original). The Examiner further acknowledged that unity of invention pursuant to the provisions of PCT Rule 13 is not lacking in applicants' claims.

7. In their reply pursuant to 37 C.F.R. §1.116 of November 25, 2002 (date of the Certificate of Mailing, Paper No. 09), applicants submitted that the Examiner's withdrawal of Claims 6 and 11, or of Claim 11, was deemed to be inconsistent with the concession that applicants' claims meet the unity of invention provisions. Applicants further sought

- (a) to obviate the Examiner's reasons for finding Claim 11 unclear, and
- (b) to introduce the limitations of Claim 11 into Claim 1 from which Claim 11 depends.

8. The Examiner issued an advisory action on December 12, 2002 (Paper No. 10), indicating

- (a) that the proposed amendment(s) will not be entered because they are not deemed to place the application in better form for appeal (No. (2c) of form PTO-303), and
- (b) that Claims 6 and 11 remain withdrawn from consideration (No. (7) of form PTO-303).

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2) See also footnote (1).

9. This Petition follows. A Notice of Appeal including a request and fee for a one month extension of time is being filed along with this Petition.

M E M O R A N D U M

It is applicants' position that the Examiner erred when holding Claims 6 and 11, or Claim 11, withdrawn from consideration in the application.

The Examiner expressly acknowledged that unity of invention with regard to Claims 6 and 11 is not lacking. PCT Article 27(1) which applies to applications filed under Section 371 provides "*No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and its Regulations*" (emphasis added). Accordingly, the restriction of an application, as well as the withdrawal of claims pending in an application, is governed by the PCT provisions and, more particularly, by the unity of invention provisions set forth in PCT Rule 13. Since the Examiner has acknowledged that Claims 6 and 11 meet the unity of invention criteria, the withdrawal of these claims from consideration in the application is inconsistent with the law governing restriction of the application. Rather than withdrawing the claim(s), the Examiner should have given Claims 6 and 11, or Claim 11, full and fair consideration in a non-final Office action, and should have provided applicants with a full and fair time period to respond to arguments raised by the Examiner why the subject matter of the claim(s) is unpatentable.

Since the Examiner's withdrawal of applicants' Claims 6 and 11 lacked appropriate legal basis, the Examiner's arguments in the final action concerning Claim 11 constitute new grounds of rejection which could, at least in part, and should have been raised in the Office action dated April 23, 2002 (Paper No. 06). The Examiner argued in the final action that

- (a) "... there are no clear definitions for  $X^1$  and  $X^5$ ; ..." and
- (b) "... "5-F" for  $X^2$  is unclear." (emphasis original).

Claim 11 as submitted by applicants in their reply dated November 26, 2001 (Paper No. 05) read as follows:

A fungicidal mixture as defined in claim 1, wherein in the compound of the formula II,  $R^1$  is methylenecyclopropyl,  $X^2$  is 5-F,  $X^3$ ,  $X^4$  and  $X^5$  are each H,  $R^2$  is  $C_6H_5CH_2$  and  $R^3$  and  $R^4$  are each H.

Accordingly, Claim 11 as before the Examiner at the time at which the first action on the merits issued

- (a) incorporated the definition of  $X^1$  by reference to Claim 1, and
- (b) defined the radical  $X^2$  as "5-F".

At the least those two issues, therefore, could and should have been raised by the Examiner in the non-final action which issued on April 23, 2002 (Paper No. 06).

It is also respectfully noted that those issues which were raised by the Examiner for the first time in the final action concern the clarity of the claim language and are therefore, in fact, issues under Section 112, ¶2, of the Patent Act. Rather than authorizing the Examiner to withdraw claims from consideration in an application for lack of definiteness, the respective provision provides that it is upon an applicant to submit claims drawn to "the subject matter which the applicant regards as his invention." The Examiner's withdrawal of Claim 11 is therefore also not deemed to conform with the holdings in, for example, In re Wolfrum (486 F.2d 588, 179 USPQ 620 (CCPA 1973)), In re Haas (486 F.2d 1053, 179 USPQ 623 (CCPA 1973)), In re Weber (580 F.2d 455, 198 USPQ 328 (CCPA 1978)), In re Haas (580 F.2d 461, 198 USPQ 334 (CCPA 1978)) and In re Harnish (206 USPQ 300 (CCPA 1980)).

In light of the foregoing, the pertinent facts in the present case corroborate that applicants' amendment which was submitted under Rule 116 should have been entered by the Examiner. Furthermore, in light of the Examiner's indication in the advisory action (Paper No. 10) that the finality of the Office action of August 27, 2002 (Paper No. 08) will be maintained, and that entry and consideration of applicants' reply dated November 25, 2002 (Paper No. 09) is denied, applicants have been denied a full and fair opportunity to argue or suitably address the issues raised by the Examiner.

#### C O N C L U S I O N

Applicants therefore respectfully request that the Examiner's advisory action dated December 10, 2002 (Paper No. 10), and that the

Examiner be required to enter and fully consider applicants' amendment dated November 25, 2002 (*Paper No. 09*), and to issue a new advisory action. Favorable action is respectfully solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF



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